

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alan Cox Examiner: Goldberg, A. C.
Serial No.: 10/624,445 Art Unit: 2491
Filed: July 22, 2003 Confirmation No.: 6446
Entitled: **Electronic Mail Control System**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

Appellant submits this Reply Brief in response to the Examiner's Answer mailed on December 22, 2010. The Examiner's Answer contains no new ground of rejection.

I. ARGUMENT

The Examiner’s Answer fails to address issues that Appellant raised in the opening brief. For example, the Examiner’s Answer fails to show that the combinations of references cited by the Examiner during prosecution render obvious the pending claims. For example, the Examiner’s Answer fails to show that the combination of Lu (US 2002/0107950) and Hickey (US 2002/0087646) discloses all of the required elements of Appellant’s independent claims 18 and 26. The Examiner’s Answer also fails to show that the combination of Lu, Bulfer (US 2006/0036701), and Sherman (US 2002/0194177) discloses all of the required elements of Appellant’s independent claims 18 and 26. As a result, all the claims at issue should be allowed.

A. The Combination of Lu and Hickey Does Not Disclose All of The Elements Recited in Independent Claims 18 and 26

The combination of Lu and Hickey does not teach or suggest all of the limitations of independent claims 18 and 26. More specifically, the combination fails to teach or suggest at least the following limitation of independent claims 18 and 26:

once the electronic message is approved or rejected by one approver, notifying the at least one other approver of a changed status for the electronic message wherein the notifying includes providing to the at least one other approver an indicator to be associated with the other approver's copy of the electronic message, the indicator characterizing the changed status.

(emphasis added)

The Examiner stated that Lu fails to teach this limitation (“notifying limitation”), but Hickey does. (Office Action dated February 22, 2010, p. 8). In response, Appellant pointed out in the opening brief that the status indicators described in Hickey (e.g., status indicator 57yxz described in paragraph [0043]) are not associated with another approver’s copy of the electronic messages as the rejected claims require. (Appeal Brief, p. 8). Perhaps realizing the deficiency in Hickey, however, the Examiner stated in the Examiner’s Answer that “Hickey is used to show the simple concept of notification updates when a particular email is acted upon by a supervisor.” (emphasis added) (Examiner’s Answer, p. 52). Appellant wishes to point out that no part of the subject matter of the claimed invention is an abstract concept. Rather, the claimed invention pertains specifically to a particular way of implementing the concept of, among other things, notifying another approver by “providing to the . . . approver an indicator to be associated with the [] approver’s copy of the electronic message.”

The Examiner also stated in the Examiner’s Answer that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” (Examiner’s Answer, p. 50). Appellant wishes to point out that Appellant has never attacked the cited references individually. Rather, Appellant showed that the combination of Lu and Hickey fails to teach or suggest the notifying limitation by pointing out that Hickey too fails to teach or suggest that which the Examiner admitted Lu does not. Appellant submits that when an examiner purports to show that a combination of two or more references teaches or suggests a claimed subject matter, the teaching or suggestion must be found somewhere within the references. It is improper for the examiner to assert without support that two references, neither of which teaches or suggests a missing element, teaches or suggests the missing limitation when combined. However, this is exactly what the Examiner is trying to accomplish. Lu does not teach or suggest the notifying limitation, and neither does Hickey. Yet according to the Examiner, when Lu and Hickey are combined, the missing limitation allegedly arises from the combination without clear support. Lu, according to the Examiner, teaches a “decentralized

email monitoring system in which multiple supervisors may be sent an individual copy.” (Examiner Answer, p. 50). Hickey, according to the Examiner, is used to show that “when a particular email is acted upon by a supervisor . . . each user’s screen is notified according to the supervisor’s decision.” (Examiner’s Answer, p. 52). In other words, Hickey shows that when a supervisor acts on an electronic mail, other supervisors are notified because they will look at the same email in an inbox shared by all of the supervisors. Though the Examiner insists that he is “not depending on Hickey to disclose a centralized email monitoring system” (Examiner Answer, p. 51), by virtue of the fact that Hickey is about a centralized email monitoring system, Hickey cannot and need not show “providing to . . . [an]other approver an indicator to be associated with the [] approver’s copy of the electronic message,” simply because there is no additional “copy of the electronic message” for that another approver. Lu, as admitted by the Examiner, does not teach or suggest the notifying limitation. And Hickey, while describing a centralized email monitoring system, cannot and need not teach or suggest the missing limitation. The two references, neither of which teaches or suggests the missing limitation, cannot teach or suggest the missing limitation when combined by the Examiner using the benefit of hindsight.

In fact, Hickey teaches away from creating independent copies of electronic communications as required by the rejected claims. Hickey, as Appellant presented in the opening brief (Appeal Brief, p. 9), discusses the difficulties associated with maintaining multiple, independent copies of an e-mail. Appellant wishes to point out that Hickey’s solution to overcome the stated difficulties was to move away from a decentralized email monitoring system. Whereas the claimed invention teaches a novel way of handling such difficulties by “providing to [an]other approver an indicator to be associated with the [] approver’s copy of the electronic message,” Hickey teaches away from the claimed invention by teaching a centralized email monitoring system wherein a group mailbox is devised for multiple supervisors to share a single copy of an email. The Examiner states in the Examiner’s Answer that “Hickey sites [sic] the difficulty, not the impossibility of notifications in a decentralized system” (emphasis in the original) (Examiner’s Answer, p. 53) but Appellant wishes to point out that whether notification in a decentralized system is impossible or not has little to do with Appellant’s argument. Neither has it anything to do with any recognized legal standard. What Appellant stated in the opening brief and wishes to emphasize herein again is that Hickey avoided the stated difficulties by

moving away from a decentralized email monitoring system altogether, thereby teaching away from a solution that is applicable to a decentralized email monitoring system, or at a minimum did not provide any teaching or suggestion for such solution.

Next the Examiner states that “the claim makes no mention that a different decision can be made by two approvers” (Examiner Answer, p. 52) and that the “claim therefore ignores the necessity of an independent e-mail copy by providing the same intended use when a supervisor approves/rejects an email.” (Examiner Answer, p. 53). Appellant wishes to point out that a part of the invention is “providing to the at least one other approver an indicator to be associated with the other approver’s copy of the electronic message” such that no two or more approvers will be required to duplicate the effort or that no two or more approvers will inadvertently perform contradicting acts, while maintaining individual copies of the email.

B. The Combination of Lu, Bulfer, and Sherman Does Not Disclose All of the Elements Recited in Independent Claims 18 and 26

The combination of Lu, Bulfer, and Sherman does not teach or suggest all of the limitations of independent claims 18 and 26. More specifically, the combination fails to teach or suggest at least the “notifying limitation.” The Examiner stated that neither Lu nor Bulfer teaches or suggests the notifying limitation, but Sherman does. (Office Action dated February 22, 2010, p. 33). In response, Appellant pointed out in the opening brief that no portion of Sherman cited by the Examiner teaches or suggests the notifying limitation. (Appeal Brief, pp. 13-14). Perhaps realizing the deficiency in Sherman, however, the Examiner cited in the Examiner’s Answer a statement made by Appellant in 2005 with respect to then independent claims 16 and 17, which were subsequently canceled. The Examiner then compares the 2005 statements with the statements made by Appellant with respect to an old version of claims 18 and 26, which had different limitations and scopes. For example, canceled claim 16 included a limitation, “synchronizing the display to the first approver and the display to the second approver of representations of electronic messages that have been presented for approval.” (emphasis added). None of these claim terms, including the term “synchronizing,” appears in the present version of claims 18 and 26 at issue.

The Examiner also stated in the Examiner Answer that “[d]espite the reversal in stance, the examiner maintains the first admission that the invention involves synchronizing folders between multiple approvers.” Appellant wishes to point out that there was no reversal in stance.

Appellant stated with respect to the canceled claim 17, for instance, that “the applied references fail to disclose . . . the type of synchronizing performed by the claimed invention.” (emphasis added). The “claimed invention” refers to the canceled claim 17 and not the present version of claims 18 and 26, which are at issue in this appeal. Appellant was simply pointing out in 2005 that the cited reference (Dieterman) does not disclose or suggest the type of synchronizing (*i.e.*, synchronizing the display) performed by the claimed invention (*i.e.*, canceled claim 17). The Examiner has apparently taken out of context and mischaracterized Appellant’s 2005 statements with respect to claims that were subsequently canceled and thus are not at issue.

Appellant has reviewed the Appellant’s response dated August 6, 2007 but could not find the statements that the Examiner alleged were made by Appellant. Appellant searched the prosecution history and found the statements cited by the Examiner at page 3 of Appellant’s response dated September 28, 2008. The alleged 2008 statements, however, do not indicate that Appellant reversed stance with respect to “synchronization.” In the 2008 response, Appellant was dealing with different versions of claims 18 and 26, which were amended many times thereafter until 2010 when the appeal was filed. Again, the Examiner has apparently taken out of context and mischaracterized Appellant’s 2008 statements with respect to old version of claims 18 and 26 (which as of the 2008 response, were last amended in the August 2007 response to which the Examiner refers). Those claims have since gone through multiple amendments.

Appellant wishes to point out that Appellant never admitted that the invention requires synchronizing, much less synchronizing folders between multiple approvers. In fact, the September 28, 2008 response provides support for the proposition that synchronizing is not required for notification:

“Nothing in the specification implies that synchronization is an essential element regarding notification. Nothing in the specification explicitly precludes other forms of notifying. In fact, paragraph [0006] (near the end) describes general notification of approvers relating to the electronic mail messages. Here, notification of approvers is described in the context of, “. . . one or more of the approvers can be notified automatically if a new message is received or has not been reviewed after a particular period of time.” (emphasis added). Further, paragraph [0025] describes a child receiving notice when messages are rejected. The specification therefore clearly describes notification of electronic message status in forms other than through synchronization.

At paragraph [0006], the specification discloses that, “[m]ultiple people can have approval authority, and the actions taken by each approver can be synchronized.”

(emphasis added). Synchronization is therefore not required – this argument is further supported at the end of paragraph [0028], “[i]t should be understood that the current invention is not limited to situations in which some form of synchronization is used or required.””

Appellant also wishes to point out that the present application has a long prosecution history (over 5 years) in which all of the original claims were canceled and the subsequently added new claims were amended more than once. The Examiner has apparently taken different portions of such long file history out of context and mischaracterized them.

Appellant submits that neither Lu nor Bulfer teaches or suggests “providing to . . . [an]other approver an indicator to be associated with the [] approver’s copy of the electronic message.” For example, Bulfer is relied on to show an “approval folder.” Sherman also fails to teach or suggest the required notifying limitation. For example, Sherman was relied on to show synchronizing folders but this synchronization of folders is not triggered by notifications amongst different approvers. Neither Lu nor Bulfer nor Sherman nor any combinations thereof teaches or suggests the required limitation of “providing to . . . [an]other approver an indicator to be associated with the [] approver’s copy of the electronic message.”

II. CONCLUSION

Appellant has shown defects in the Examiner’s effort to establish a case for obviousness. The Examiner’s Answer does not rebut Appellant’s showing of these defects. Under these circumstances, no *prima facie* case of obviousness has been established. Hence, Appellant requests that the Board reverse the outstanding rejections under 35 U.S.C. § 103(a), remand the application to the Examiner, and direct the Examiner to issue a Notice of Allowance.

No additional fees are believed to be due. However, please charge any payments due or credit any overpayments to our Deposit Account No. 08-0219.

Respectfully Submitted,

/Peter W. Baik/
Peter W. Baik
Registration No. 58,707

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Wilmer Cutler Pickel Hale and Dorr, LLP
399 Park Avenue
New York, NY 10022
212-937-7275 (telephone)
212-230-8888 (facsimile)